

909

IN THE CIRCUIT COURT OF THE UNITED  
STATES

FOR THE SOUTHERN DISTRICT OF NEW YORK.

AMERICAN GRAPHOPHONE COMPANY

v.

UNIVERSAL TALKING MACHINE MANU-  
FACTURING COMPANY

In Equity.  
On Jones Patent  
No. 688,739.

910

**"Complainant's Exhibit, File and Contents  
Berliner vs. Jones Interference."**

[Notarial Seal.]

WM. B. KERKAM,  
Notary Public, D. C.,  
Acting Sp'l Ex.

911

2-389.

UNITED STATES OF AMERICA.

[Coat of Arms.]

912

DEPARTMENT OF THE INTERIOR,

PATENT OFFICE.

TO ALL PERSONS TO WHOM THESE PRESENTS SHALL COME  
GREETING : -

This is to certify That the annexed is a true copy  
from the Records of this office of the File Wrapper  
and Contents in the matter of Interference Number



234 Complainant's Exhibit, File Wrapper.

913

21,102, Berliner vs. Jones, Subject-Matter :—Gramophone Sound-Records and Method of Making Same.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington this eighteenth day of March, in the year of our Lord one thousand nine hundred and five and of the Independence of the United States of America the one hundred and twenty-ninth.

[SEAL.]

914

F. I. ALLEN

Commissioner of Patents.

Room No.

All communications should be addressed to

"The Commissioner of Patents,  
Washington, D. C."

915

J. H. D.

U. S. PATENT OFFICE,  
Apr 15 1901  
Div. 23.

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., Apr 17, 1901

Mailed " " "

# 21,102

916

**EXAMINER OF INTERFERENCES :**

An interference is found to exist between the following cases, and in respect to the invention therein specified, to wit:

**CASES.**

1. Emile Berliner, of Washington, D. C., for Gramophone Sound-Records and Method of Making the Same, filed Mar. 13, 1900, # 8537, whose attorneys are



Lyons & Bissing, of McGill Bld'g., Wash., D. C.  
Assor to self & Joseph A. Vincent of Philadelphia, Pa.

2. Joseph W. Jones, of New York, N. Y., for Method  
or Process of Making Records for the Reproduction of  
Sound Waves, filed Nov. 19, 1897; Ser. No. 659,170,  
whose attorney is A. S. Williams, of # 903 Walnut  
Street, Philadelphia, Pa., and whose asso. atty. is  
Philip Mauro, Wash., D. C.

917

INVENTION.

918

Count

The herein described method of producing sound-  
records, which consists in cutting or engraving upon a  
tablet of suitable material, by means of the lateral  
vibrations of a suitable stylus, a record-groove of  
appreciable and practically uniform depth and having  
lateral undulations corresponding to the sound-waves,  
next coating the same with a conducting material, then  
forming a matrix thereon by electrolysis, and finally  
separating this matrix and pressing the same into a  
tablet of suitable material.

919

The foregoing count is Berliner's claim 7 and Jones  
claim 1.

J. T. NEWTON.

Ex.

[ENDORSED:] Intf. No. 21,102 Paper No. 1 Ber-  
liner v. Jones. Declaration of Interference of Apr.  
17" 1901. Time for filing statement set for May 10" 1901.

920



921

IN THE UNITED STATES PATENT OFFICE.

BERLINER

vs.

JONES

Interference No.  
21,102.

922

**Preliminary Statement.**

STATE OF NEW YORK, }  
County of New York, } ss.:

923 JOSEPH W. JONES, being first duly sworn, deposes and says that he is the Joseph W. Jones whose application for Method or Process of Making Records for the Reproduction of Sound-waves, filed Nov. 19, 1897, serial No. 659,170, is involved in an Interference with a pending application of Emile Berliner of Washington, D. C., for Gramophone Sound-Records and Method of Making the Same.

Deponent further avers that he conceived the said invention some time during the Fall and Winter of the year 1896-7, about Dec. 1, 1896.

924 That he disclosed the said invention (particularly as set forth by present claim 1 of his said application) to others about the same time, and on subsequent occasions at different intervals up to the date of filing the said application.

That he reduced his said invention (particularly as set forth by said claim 1) to constructive practice by filing his said application in the U. S. Patent Office on Nov. 19, 1897.

And that, save for instructions given to his attorney in preparing the said application, he made no sketches illustrating the same, and never made a model as dis-



925

inct from a full and complete carrying out of the invention in a practical manner.

And that since filing his said application he has carried out the said invention to a great extent, by making a very large number of sound-records in accordance with the said invention, and by using and selling the same.

JOSEPH W. JONES

Subscribed and sworn to be-  
fore me, this 3rd day of }  
May, 1901.

926

(Notarial Seal)

ELISHA CAMP,  
Notary Public,  
N. Y. Co.

[ENDORSED:] 21,102 2 Berliner vs. Jones State-  
ment of Jones. Filed May 6, 1901 Approved May  
11, 1901 F. B.

927

928



238 Complainant's Exhibit, File Wrapper.

929

2-207.

Duplicate.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

930

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., May 6, 1901

In the Matter of the Interference of

BERLINER

VS

JONES

Before the Exam-  
iner of Interfer-  
ences.  
Intf. No. 21,102.

931

SIR: You are hereby informed that the preliminary  
statement of Joseph W. Jones, has been received and  
filed.

By direction of the Commissioner:

Very respectfully,

C. M. IRELAN

Acting Chief Clerk.

Per G.

932

JOSEPH W. JONES,  
Care Philip Mauro,  
City.

Intf. No. 21102 Paper No. 3

[ENDORSED:] Intf. No. 21102 Paper No. 3 Ber-  
liner vs Jones Acknowledgment of receipt of State-  
ment of Jones. May 6, 1901.



IN THE UNITED STATES PATENT OFFICE

EMILE BERLINER,

VS.

JOSEPH W. JONES.

Interference in the  
United States  
Patent Office.

HON. COMMISSIONER OF PATENTS,

SIR: On April 17th, 1901, an interference was declared, by the Examiner of Interferences, between my application for Letters Patent, Serial No. 8537, filed March 13, 1900, and an application of Joseph W. Jones, upon an issue defined in these words:

"The herein described method of producing sound records, which consists in cutting or engraving upon a tablet of suitable material, by means of the lateral vibrations of a suitable stylus, a record-groove of appreciable and practically uniform depth and having lateral undulations corresponding to the sound-waves, next coating the same with a conducting material, then forming a matrix thereon by electrolysis, and finally separating this matrix and pressing the same into a tablet of suitable material."

The filing of the preliminary statements was fixed for May 10th, 1901.

Between the time when the interference was declared and this date, I have discovered evidence that convinces me that the subject matter of the issue of this interference is not patentable to me or to anybody who did not conceive the invention at issue prior to the year 1879.

Of the references upon which I rely, among others, in support of my belief that the issue is not patentable, I may cite:

1. An article in the scientific periodical "Engineer-



937

ing" published in London, describing the Lambrigot Phonograph in Vol. 27, page 326; *et seq.*, April 18, 1879; the article being entitled "A Six Penny Phonograph."

2. British Patent to Gouraud (a communication from Thomas A. Edison) # 15,206 of 1891.

938

While I believe that the description of the Lambrigot Phonograph alone fully anticipates the process defined by the issue; the British patent only fortifies that belief, since it shows that *laterally undulating cut-wax records* came into existence at that date, so that even if "Engineering" alone were insufficient to anticipate the issue, which is not the case, the British patent in connection with the Lambrigot publication would surely defeat any patent granted upon the issue defined by the Examiner of Interferences.

939

It is unreasonable to believe that the contestant, Jones, should have begun work on the process defined by the issue at such an early date as the Lambrigot publication, and I know that I had not begun work as early as that. From this it follows, if my surmise as respects Jones is correct, that the subject matter of the issue is not patentable either to me or to him. Believing this, I should not file a preliminary statement if I were left to my own volition. But since the interference has been declared, and since the Patent Office might possibly consider the issue patentable notwithstanding the publications which I cited and the facts which I am prepared to prove, I have undertaken to prepare a statement of the material point of my activity in the line of the process defined by the issue, and I herewith transmit the same as my preliminary statement. But not believing that the issue is patentable, I shall, within the time fixed by the Rules of Practice, make a motion for dissolution of this interference, upon the ground that the subject-matter of this interference is not patentable to either of the parties.

940

Respectfully submitted,

EMILE BERLINER

Washington, D. C. May 10, 1901.



IN THE UNITED STATES PATENT OFFICE

EMILE BERLINER,

vs.

JOSEPH W. JONES.

Interference in the  
United States  
Patent Office.  
Preliminary state-  
ment of Emile Ber-  
liner.

EMILE BERLINER, of Washington, in the District of Columbia, being duly sworn, doth depose and say that he is a party to the interference declared by the Commissioner of Patents, April 17, 1901, between his application for Letters Patent, having the serial number 8537, filed March 13, 1900, and an application of Joseph W. Jones; that he conceived of the process set forth in the declaration of interference on or about June 27, 1887; that, in the nature of things, the said process is incapable of being represented by drawings; that he cannot now state when he first explained the said process to others; that on or about the same day he first practiced the initial step of the process involved in the issue of this interference; that in the early summer of 1893 the process defined by the issue of this interference was substantially practiced, under his directions, in the City of Boston, Massachusetts; that in January and February 1900, he again practiced the process defined by the issue of this interference in the City of Washington, D. C., and that he has not, by the said process, manufactured articles for sale.

EMILE BERLINER

Subscribed and sworn to be-  
fore me this 10th day of  
May, 1901.

EDWIN S. CLARKSON

(Notarial Seal).

Notary Public

D. C.

[ENDORSED:] 21,102 4 Berliner vs. Jones State-  
ment of Berliner. Filed May 10, 1901 Approved May  
11, 1901 F B



242 Complainant's Exhibit, File Wrapper.

945

2-207.

Duplicate.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

946

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,  
WASHINGTON, D. C., May 10, 1901

In the Matter of the Interference of

BERLINER

VS

JONES

Before the Exam-  
iner of Interfer-  
ences.  
Intf. No. 21,102

947

SIR: You are hereby informed that the preliminary  
statement of Emile Berliner has been received and  
filed.

By direction of the Commissioner:

Very respectfully,

C. M. IRELAN

Acting Chief Clerk.

Per G.

948

EMILE BERLINER,  
Care Lyons & Bissing,  
McGill Bl'd'g, City.

Intf. No. 21102 Paper No. 5.

[ENDORSED:] Intf. No. 21102 Paper No. 5. Ber-  
liner vs Jones. Acknowledgment of receipt of state-  
ment of Berliner May 10, 1901



2-065.

Room No. 44.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

DEPARTMENT OF THE INTERIOR,

950

UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., May 13, 1901  
Mailed " " "

*In re* Interference

BERLINER

v.

JONES

Interference No.

21,102

Before the Exam-  
iner of Interfer-  
ences.

951

Subject-matter: Gramophone Sound Record and  
Method of Making Same.

EMILE BERLINER

c/o Lyons & Bissing

McGill Bdg., Washington, D. C.

The statement filed by Berliner is defective in that 952  
it does not state when the invention was disclosed to  
others nor does it state definitely when it was reduced  
to practice.

What is meant by the words "substantially prac-  
ticed" is uncertain.

An amended statement must be filed on or before  
May 24, 1901

In case of failure to file the amended statement  
required, or to explain the apparent defect noted  
above, the statement already filed will be approved,



244 Complainant's Exhibit, File Wrapper

953

but Berliner will be restricted to his record date as to disclosure and to Feb 1900 as to reduction to practice in the further proceedings in the case. (See Amended Rules 110 and 112, edition of 1897.)

WALTER JOHNSON  
Examiner of Patents

Int'l No. 21,102 Paper No. 3

954

[Enclosed 7 Int'l. No. 21,102 Paper No. 6. Berliner v. Jones. Letter to Berliner extending preliminary hearing to May 24, 1901. May 18, 1901.

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956



Complainant's Exhibit, File Wrapper. 245

957

2-223.

Room No. 1.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,

958

WASHINGTON, D. C., May 13, 1901  
Mailed " " "

*In re* Interference

BERLINER

v.

JONES.

# 21,102  
Before the Exam-  
iner of Interfer-  
ences.

959

Subject-matter: Gramophone Sound Record and  
Method of Making Same.

JOSEPH W. JONES,  
c/o Philip Mauro  
Washington, D. C.

The time for filing statements has been extended to 960  
May 21, 1901 to allow Berliner to file an amended  
statement.

WALTER JOHNSON  
Examiner of Interferences.

Intf. No. 21,102 Paper No. 7

[ENDORSED:] Intf. No. 21,102 Paper No. 7 Ber-  
liner v. Jones Letter to Jones extending prel. hearing  
to May 21, 1901. May 13, 1901.



961

IN THE UNITED STATES PATENT OFFICE

962

EMILE BERLINER,

VS.

JOSEPH W. JONES.

Interference in the  
United States  
Patent Office.  
Amended Prelimi-  
nary Statement of  
Emile Berliner.

963

EMILE BERLINER, of Washington, in the District of Columbia, being duly sworn, doth depose and say that he is a party to the interference declared by the Commissioner of Patents, April 17, 1901, between his application for Letters Patent, having the serial number 8537, filed March 13, 1900, and an application of Joseph W. Jones, and that he has already filed a preliminary statement in this interference on May 10, 1901. Deponent now says that he conceived of the process set forth in the declaration of interference on or about June 27, 1887; that, in the nature of things, the said process is incapable of being represented by drawings; that, so far as he can now ascertain, he first explained the said process to others some time during the year 1892; that on or about June 27, 1887, he first practiced the initial step of the process involved in the issue of this interference; that he has now ascertained that in the summer of 1892, and not later than October 1892, the same process which is defined by the issue of this interference was practiced, under his directions; that in January and February, 1900, he again practiced the process defined by the issue of this interference in the City of Washington, D. C.,

964



and that he has not, by the said process, manufactured  
articles for sale.

965

EMILE BERLINER

Sworn and subscribed to be-  
fore me this 24th day of  
May 1901.

HUGH M. STERLING

(Notarial Seal).

Notary Public.

[ENDORSED:] 21,102 4/8 Berliner vs. Jones State-  
ment of Berliner Filed May 24, 1901 Approved  
May 25 1901 W N S

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248 Complainant's Exhibit, File Wrapper.

969

2-207.

Duplicate.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

970

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,  
WASHINGTON, D. C., May 24, 1901

In the Matter of the Interference of

BERLINER

VS

JONES.

Before the Exam-  
iner of Interfer-  
ences.  
Intf. No. 21,102.

971

SIR: You are hereby informed that the amended preliminary statement of Emile Berliner has been received and filed.

By direction of the Commissioner:

Very respectfully,

E. V. SHEPARD,  
Chief Clerk.

972

EMILE BERLINER,  
Care Lyons & Bissing,  
McGill Bld'g, City

Intf. No. 21,102 Paper No. 9.

[ENDORSED:] Intf. No. 21,102 Paper No. 9. Ber-  
liner vs Jones Acknowledgment of receipt of amended  
statement of Berliner, May 24, 1901.



973

2-214

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,

E. M. P.

WASHINGTON, D. C., May 25, 1901.

974

*In Re* Interference

BERLINER

v.

JONES.

No. 21,102.  
Before the Exam-  
iner of Interfer-  
ence.

975

Subject-matter: Gramophone Sound-Records and  
Method of Making Same.

EMILE BERLINER,  
C/o Lyons & Bissing,  
McGill Bldg., Washington, D. C.  
JOSEPH W. JONES,  
C/o Philip Mauro,  
Washington, D. C.

976

The parties hereinafter named are hereby notified that, as to their inventions adjudged to interfere with each other in the particulars specified in office letter of the 17th of Apr., 1901, a hearing will be granted on the 12th day of Sept., 1901.

The testimony of the respective parties must be closed previous to the dates hereinafter designated. The party first filing an application for a patent will be deemed the first inventor, in the absence of proof to the contrary.

Rebutting testimony, but no other, may be taken by



977

parties on whom rests the burden of proof after the closing of the testimony of the party who first filed his application.

All testimony must be taken, forwarded and printed in accordance with the published Rules of Practice of the Office.

No testimony to be taken before June 14, 1901.

Emile Berliner, of Washington, D. C. filed application Mar. 13, 1900. Serial No. 8537.

978 Testimony must be closed July 15, 1901.

Attorney of Record Lyons & Bissing, McGill Bld., Washington, D. C.

Joseph W. Jones, of New York, N. Y. filed application Nov. 19, 1897. Serial No. 659,170.

Testimony must be closed Aug. 5, 1901.

Attorney of Record P. Mauro, Washington, D. C.

Rebutting testimony by Berliner must be closed Aug. 20, 1901.

979

WALTER JOHNSON  
Examiner of Interferences

[ENDORSED:] Intf. No. 21,102 Paper No. 10 Berliner v. Jones. Order setting time for taking testimony. Hearing for Sept. 12" 1901 May 25, 1901.

980



981

IN THE UNITED STATES PATENT OFFICE

BERLINER,

vs.

JONES.

In Interference  
No. 21,102.

982

WASHINGTON, D. C., June 20th 1901.

PHILIP MAURO, Esq.

Attorney for Joseph W. Jones

Washington, D. C.

983

SIR : Please take notice that on Tuesday, June 25th 1901, at 11 o'clock A. M., or as soon thereafter as counsel can be heard, we shall move the Examiner of Interferences to transmit the annexed motion to the Primary Examiner for adjudication.

Very respectfully,

LYONS & BISSING.

Attorneys for Emile Berliner.

984



252 Complainant's Exhibit, File Wrapper.

985

Service of the above notice and motion, and copies of the same, is acknowledged this 20th day of June 1901.

PHILIP MAURO  
Attorney for Joseph W. Jones.

Int. No. 21102 Paper No. 11

986

IN THE UNITED STATES PATENT OFFICE

BERLINER

VS.

JONES.

In Interference  
No. 21,102.

987

**Motion.**

And now comes Emile Berliner, one of the parties to the above entitled interference, by his attorneys, and moves that this interference be dissolved upon the ground that the subject matter defined by the issue is not patentable, for lack of invention, in view of the prior state of the art as disclosed in patents and printed publications set forth in the accompanying affidavit.

988

It is also moved that this motion be transmitted to the Primary Examiner, for his determination thereof, and that, pending such determination, other proceedings in this case be suspended.

Respectfully,  
LYONS & BISSING.  
Attorneys for Emile Berliner.



899

## IN THE UNITED STATES PATENT OFFICE

BERLINER

VS.

JONES.

In Interference  
No. 21,102.

990

CITY OF WASHINGTON, }  
District of Columbia. } SS.

JOSEPH LYONS, of the City of Washington, in the District of Columbia, being duly sworn, deposes and says that he is one of the attorneys of Emile Berliner, one of the parties to the interference # 21,102, declared by the Commissioner of Patents on April 17, 1901, between the application of the said Emile Berliner, Serial No. 8537, filed March 13, 1900, and the application of Joseph W. Jones, Serial No. 659,170, filed November 19, 1897, and that he is familiar with the subject-matter of this interference and with the proceedings so far had in this case.

991

Deponent further says that he believes that the subject-matter of that interference, as defined in the declaration, is not patentable, for the reason that the same is substantially disclosed in anticipating publications, to wit:

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FIRST—In the Encyclopaedia Britannica, Vol. XXIII, 9th edition, published in New York by Charles Scribner's Sons in the year 1888, on page 703 of said volume.

SECOND—In an article in the scientific periodical "Engineering" published in London April 18, 1879, and entitled: "A Six Penny Phonograph", describing the Lambrigot Phonograph in Vol. XXVII, page 326, *et seq.*



993

THIRD—In British Patent to Gouraud (a communication from Thomas A. Edison) # 15,206 of 1891.

Deponent further says that he believes that in view of the disclosures found in the above named references no room for invention is left in practicing the method defined by the issue of this interference.

JOSEPH LYONS.

994

Sworn to and subscribed before me this 20th day of June 1901.

EDWIN S. CLARKSON

(Notarial Seal).

Notary Public.

D. C.

[ENDORSED:]

Intf. No. 21,102 Paper No. 11. Berliner vs. Jones.  
Motion by Berliner for dissolution.

U. S. Patent

June 20 1901

995

Office

996



2-231.

Room No. 63.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

G. L. B.

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., June 27, 1901.

Mailed " " " "

*In re* Interference

BERLINER

v.

JONES.

Intf. No. 21,162.  
Before the Exam-  
iner of Interfer-  
ences.

Gramophone Sound Records & Method of Making  
Same.

EMILE BERLINER,

C/o Lyons & Bissing,

McGill Bldg., Washington, D. C.

JOSEPH W. JONES,

C/o Philip Mauro,

Washington, D. C.

On May 25, 1901, this interference was finally de-  
clared and times were set for taking testimony and for  
final hearing. Thereafter and on June 20th, Berliner  
filed a motion to dissolve, a motion to transmit to the  
primary examiner, and a motion for a suspension of  
proceedings pending the final determination of the



1001

motion to dissolve. Said motion for transmission was noticed for hearing on the 25th day of June, instant, at 11 o'clock, A. M., at which time both parties appeared by attorney. Counsel for Berliner stated that a stipulation had been prepared and filed extending the time for bringing motions under Rule 122. No such stipulation being found in the record, it was agreed by counsel for Jones that the motion should be transmitted, notwithstanding the fact that the same

1002

was brought after the expiration of the twenty days prescribed by Rule 122. The taking of testimony is suspended pending the determination of the motion to dissolve.

In view of the agreement between counsel, no limit of appeal is set.

CHARLES F. CHISHOLM  
Acting Examiner of Interferences.

Intf. No. 21,102 Paper No. 12.

1003

[ENDORSED:] Intf. No. 21,102 Paper No. 12. Berliner v. Jones Motion to dissolve trans. to Pr. Examiner. Taking of testimy. suspended. June 27—1901.

IN THE UNITED STATES PATENT OFFICE.

1004

BERLINER

v.

JONES

Interference No.  
21,102.

**Brief for Macdonald in Opposition to  
Berliner's Motion to Dissolve.**

Berliner's action in making this motion is that of one who, knowing that his chances of prevailing are



practically *nil*, and who despairing of success, seeks to save to himself the right to use an invention of unusual value and merit, by depriving the original and first inventor of a patent covering the invention.

At the time the Examiner suggested to Berliner the claim in interference he (Berliner) raised no question whatsoever as to the patentability of the subject-matter, and unhesitatingly adopted the claim as defining a patentable invention made by him and described in his application. When the references cited against his application are compared with the claims previously made by him, it is not difficult to understand why the claim in issue was so eagerly adopted. He had been endeavoring to obtain claims fully met by the references and apparently did not appreciate wherein the real invention resided. The interference was then declared and it is to be noted that even up to this time no question had been raised as to the patentability of the issue. And it is safe to surmise that no such question would now be before the Examiner for consideration had it not been that Berliner, in looking up data for his statement, realized the weakness of his case and foresaw the probability of Jones' stronger case and ultimate success. Therefore, with a view of leaving open the only avenue of escape from the effects of an award of priority to Jones, and for the purpose of giving at least a semblance of color and sincerity to the reasons advanced in support of the motion now made, Berliner, in filing his preliminary statement, addressed a letter (signed by himself) to the Patent Office under date of May 10th, for the first time suggesting and contending the non-patentability of the issue. This contention he supported (and still supports) by evidence which he says he discovered

*"Between the time when the interference was declared and this date" (May 10, 1901).*

But this is not so as to British patent to Gouraud, No. 15,206 of 1891, which had before declaration of th



1009

interference been cited in his application, nor can it be believed as to the 1879 "Engineering" article describing the Lambrigot six-penny phonograph, for Berliner is no novice in this art and professes to be thoroughly familiar with the early literature pertaining thereto of which this article forms a prominent part. The same is true of Mr. Lyons (Berliner's counsel) who has long been familiar with the "Engineering" article. The common and well-known method of electroplating type, etc., explained in Vol. XXIII, page 703 of the Encyclopaedia Britannica, referred to for the first time in the motion papers (not mentioned in Berliner's said letter), must certainly have been well known to persons as familiar with the arts in general as Mr. Berliner and his attorney. It therefore appears that the publications now relied upon *were not discovered by Berliner after declaration of the interference*, but, on the contrary, were well known to him and his attorney when he first made the claim in issue.

1011

Comparison of the preliminary statements shows that Berliner's premonition above referred to was well founded, and explains why Berliner is now so ready to condemn as *non-patentable* that which, with precisely the same information before him (for Berliner's claim of *subsequent* discovery of *evidence* cannot be credited), he had previously so eagerly adopted as patentable. It is the proverbial case of the drowning man grasping at straws.

1012

As the alleged "anticipating publications" relied upon in support of the motion, are even less pertinent than the references over which the Examiner finally held the issue to be patentable, and furthermore, as the Examiner is undoubtedly familiar with the "Engineering" article, as well as the common method of electroplating type as explained in the Encyclopaedia Britannica, it is not believed that it is necessary to here repeat *in extenso* the arguments already advanced, particularly in view of the demonstrated and acknowledged superiority of duplicate records produced by this process.



1013

Berliner, under circumstances which do not commend his action to serious consideration, but, on the contrary, indicate that with a reasonable chance of success he would be only too glad to insist upon the merit and patentability of the issue, now asks the Examiner to reverse the conclusion which he has reached after mature deliberation. To give his contention the slightest semblance of merit, particularly under the circumstances recited above, and before the Examiner should even consent to reconsider the question of patentability, Berliner must, it is submitted, show *beyond reasonable doubt* that the citations now relied on are more pertinent than the references over which the claim was allowed. This, it is impossible for Berliner or his learned Counsel to do, for, if anything, the new citations are less pertinent. For this very reason they were not cited by the Examiner.

1014

Gouraud's British patent No. 15,206 of 1891 adds nothing because it is already of record. The most that can be said for this patent is that it describes the production of a [a line is here missing from the certified copy] although it is not believed that any such record was ever successfully produced by the patentee. It is believed to be absolutely impossible to successfully practice applicant's process by starting with a *cylindrical* record. The patent says nothing about producing duplicates from the record described.

1015

The "Engineering" article, describing the wholly impracticable and useless Lambrigot six-penny phonograph, and the equally impracticable and useless method of producing records for reproduction, is so well known to the Examiner as to call for little discussion. The most that can be said for it, so far as the present controversy is concerned, is that it suggests coating an *alleged* record in wax with plumbago and then forming a copper coating thereon, this copper coating being afterwards used as a matrix for duplicating the alleged record in a *lead* wire. But the original record described by Lambrigot is not in the form of a groove of practically uniform depth having

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1017

lateral undulations corresponding to sound waves as called for by applicant's claim. Without referring to the many other insufficiencies of this publication, it suffices to say that although it has been known to those working in the art for upwards of twenty years, no one has ever found therein a description of the process in issue or any information leading to this invention. Furthermore, it is to be noted that the publication in question is even less pertinent than references cited by the Examiner, English Patent to Young No. 1478 of 1894 for example.

1018

The Encyclopaedia Britannica article describes a process relating to a non-analogous art, and for this reason alone is not a good reference. But passing this objection for the purpose of argument, radical differences will be found:

1019

1. The article which applicant first produces and which he duplicates is a *sound record* consisting of a record-groove of practically uniform depth having lateral undulations corresponding to sound waves, formed in a tablet of a material such as wax.

The object of the process of the publication is to duplicate a *form* the essential part of which is represented by *elevations or projections* in the material, lead or the like, of which the form is made.

2. Applicant forms a *copper matrix* on his sound record by electrolysis. The publication describes forming a *matrix in wax* (applicant's original is in wax).

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3. Applicant backs his matrix. The publication describes forming a copper shell on the *matrix* by electrolysis (applicant's copper shell is his *matrix*).

4. The publication describes the necessity of completely destroying the wax matrix to separate the *copper shell* or duplicate therefrom.

Applicant does not destroy his wax record in separating the copper matrix, but may use it again in repeating his process.

5. Applicant obtains a duplicate of his original master record by pressing his copper matrix into a



1021

tablet of suitable material. The copper shell of the publication (after being backed) is not a *matrix* nor is it used as such. On the contrary, it is a duplicate of the original form and after being backed is used for printing.

Certainly this publication does not contain such a full and exact description of the process recited in the claim as to enable others to practice the same, nor does it add anything to the disclosures of the references of record.

1022

Berliner and his attorney state that they *now believe* that the publications above discussed disclose the invention in issue, although it must be assumed that they did not so *believe* when they adopted the claim. And it is safe to say they would not "believe" so now if they saw a reasonable chance of prevailing in the interference.

In support of the patentability of the issue, it is believed to be sufficient to refer to the arguments which have already been presented on behalf of Jones. 1023 Although it may be that the several steps of the process are separately or independently old, the prior art does not show that they were ever before practiced in the order specified. When so practiced they constitute a process which is not only more simple than those heretofore practiced for a similar purpose, but which yields superior results. The arguments advanced and decisions already cited on this point are believed to be ample to dispose of any arguments which Berliner can advance. 1024

The motion to dissolve should be denied.

Respectfully,

PHILLIP MAURO,

Atty.

Washington, D. C., July 31, 1901.

[ENDORSED:] Intf. No. 21,102 Paper No. 13. Berliner vs. Jones Brief for Jones in Opposition to the Motion of Berliner July 31, 1901.



262 Complainant's Exhibit, File Wrapper.

1025

2-253.

Room No. 219

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

J. H. D.

Intf. 21,102

1026

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

*Copies sent both parties*

WASHINGTON, D. C., Aug. 13, 1901.

Mailed " " "

1027

*In re Interference*

BERLINER

VS

JONES

Before the Primary  
Examiner,  
Division 23

EMILE BERLINER,

Care Lyons & Bissing,

McGill Building, Washington, D. C.

1028 JOSEPH W. JONES,

Care D. S. Williams,

# 903 Walnut Street, Philadelphia, Pa.,  
and Asso. Atty.,

PHILIP MAURO,

Washington, D. C.

Please find below a communication from the Examiner in charge of Division 23 in regard to the above-cited case.

Very respectfully,

F. I. ALLEN,  
Commissioner of Patents.



1029

Berliner brings a motion to dissolve the above-entitled interference solely on the ground

"that the subject matter defined by the issue is not patentable for lack of invention in view of the prior state of the art as disclosed in patents and printed publications set forth in the accompanying affidavit."

The examiner has carefully considered the references not already of record in either the Jones or Berliner case as well as those which had been carefully gone over during the *ex parte* proceedings but it appears that taking the whole state of the art into consideration there has been a step forward, and that this step is one that should be protected to whichever one of these applicants that finally prevails in this interference. The examiner, therefore, decides that the issue is patentable and as no appeal can be taken from this decision, (see Rule 124), the interference files will be forthwith transmitted to the examiner of interferences for further proceedings.

1030

1031

J. T. NEWTON

Ex

N

Intf. No. 21,102 Paper No. 14

[ENDORSED:] Intf. No. 21,102 Paper No. 14. Berliner vs. Jones Decision of Primary Exam on Motion Aug. 13" 1901 Recorded Vol. 67 Page 65.

1032



1033

2-231.

Room No. 63.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

E. M. P.

1034

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., Aug. 16, 1901.

Mailed " " "

*In re* Interference

1035

BERLINER

v.

JONES.

No. 21,102.  
Before the Exam-  
iner of Interfer-  
ences.

Motion for Gramophone Sound Records and Method of Mak-  
ing Same.

1036 EMILE BERLINER,  
C/o Lyons & Bissing,  
McGill Bldg., Washington, D. C.  
JOSEPH W. JONES,  
C/o Philip Mauro,  
Washington, D. C.

On August 13th, 1901, the primary examiner denied  
a motion to dissolve this interference made on behalf  
of Berliner, and such decision having become final,  
proceedings are this day resumed and times are reset  
for taking testimony and final hearing as follows:

Berliner's testimony in chief to close Sept. 16, 1901.  
Jones's testimony to close Oct. 7, 1901.



Berliner's testimony in rebuttal to close Oct. 22, 1901.

Final Hearing Nov. 15, 1901.

WALTER JOHNSON  
Examiner of Interferences.

Intf. No. 21,102 Paper No. 15.

[ENDORSED:] Intf. No. 21,102 Paper No. 15 Berliner v. Jones Procdgs. resumed. Times reset. H'g 1038  
Nov. 15, 1901. Aug. 16, 1901.

IN THE UNITED STATES PATENT OFFICE.

BERLINER

v.

JONES

Interference No. 1039  
21,102.

**Motion for Judgment on Record.**

HON. COMMISSIONER OF PATENTS,

SIR: And now comes Joseph W. Jones, the senior party in the above-entitled interference, by his attorney, Philip Mauro, and moves (under Patent Office Rule 119) that judgment of priority be rendered against the junior party, Emile Berliner, on the ground that the time within which said Berliner was required by the Patent Office to take his testimony in chief has expired, and that he (Berliner) has failed to take any testimony,—unless the said Emile Berliner shall within proper time to be fixed by the Honorable Examiner of Interferences, show good and sufficient



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cause why the judgment shall not be entered. This motion is supported by the annexed affidavit.

Respectfully,  
PHILIP MAURO,  
Attorney for Jones.

MESSRS. LYONS & BISSING,  
Attorneys for Berliner.

1042 GENTLEMEN: Please take notice that on Friday, October 4th, 1901, at 10:00 A. M., or as soon thereafter as Counsel can be heard, I will present the above motion before the Examiner of Interferences.

Respectfully,  
PHILIP MAURO,  
Attorney for Jones.

Service of copy of the above motion and accompanying affidavit acknowledged this 30th day of September, 1901.

1043

LYONS & BISSING,  
Attorneys for Berliner.

Intf. No. 21,102 Paper No. 16.

1044



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IN THE UNITED STATES PATENT OFFICE.

BERLINER

v.

JONES

Interference No.  
21,102.

1046

**Affidavit in Support of Motion.**

DISTRICT OF COLUMBIA : ss :

PHILIP MAURO, being duly sworn, deposes and says that he is the attorney of record for Joseph W. Jones, the senior party in the above-entitled interference; that the time within which the applicant Berliner, the junior party, was required to take his testimony in chief by the Patent Office expired Sept. 16, 1901, and that no notice has been received in behalf of said Berliner of his intention to take any testimony, and that to the best of deponent's information and belief said Berliner has not taken any testimony. 1047

PHILIP MAURO

Subscribed and sworn to before me this 28th day of September, 1901. }

1048

REEVE LEWIS

(Notarial Seal).

Notary Public,  
District of Columbia.

[ENDORSED :]

Intf. No. 21,102 Paper No. 16. Berliner vs. Jones  
Motion by Jones for judgment on the record.

U. S. Patent  
Sep 30 1901  
Office.



1049

2-231.

Room No. 63.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

E. M. P.

1050

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., Oct. 5, 1901.

Mailed " " "

*In re* Interference

1051

BERLINER

v.

JONES.

No. 21,102.  
Before the Exam-  
iner of Interfer-  
ences.

Gramophone Sound Records and Method of Making  
Same.

1052 EMILE BERLINER,  
C/o Lyons & Bissing,  
McGill Bldg., Washington, D. C.

JOSEPH W. JONES,  
C/o Philip Mauro,  
Washington, D. C.

On the 30th day of September, 1901, Jones filed a motion in the office for an order, under the provisions of Rule 119, entering judgment against Berliner, the junior party, unless said Berliner shall show good and sufficient cause why said judgment shall not be entered against him. This motion is based upon a showing



1053

consisting of the affidavit of Philip Mauro, Esq., associate attorney of record for Jones, setting forth that no notice of the taking of testimony by the said Berliner has been served upon the said Jones or his attorneys, and that to the best of the knowledge and belief of the said Philip Mauro no testimony has been taken by the said Berliner.

Proper proof also accompanies said motion that notice of hearing of the same has been duly served on the opposite party together with the motion and showing aforesaid. The motion came on to be heard, in accordance with said notice, on the 4th day of October, 1901, and such showing being considered sufficient, it is ordered that a judgment of priority of invention of the matter in issue in this interference be rendered against the said Berliner for the reason that he is the junior party, and has taken no testimony in the case within the time assigned him for that purpose, unless he shall on the 15th day of October, 1901, show good and sufficient cause why said judgment shall not be rendered. 1054

CHARLES F. CHISHOLM  
Acting Examiner of Interferences

Intf. No. 21,102 Paper No. 17

[ENDORSED:] Intf. No. 21,102 Paper No. 17 Berliner v. Jones Order to show cause Oct. 15, 1901. Oct. 5, 1901.

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1057

2-231.

Room No. 63.

All communications should be addressed to  
"The Commissioner of Patents,  
Washington, D. C."

G. L. B.

1058

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., Oct. 17, 1901.

Mailed " " "

*In re* Interference

1059

BERLINER

v.

JONES.

Intf. No. 21,102.  
Before the Examiner of Interferences.

Gramophone Sound Records & Method of Making Same.

1060 On the 30th day of September, 1901, Jones filed a motion for an order under the provisions of Rule 119, entering judgment against Berliner, the junior party, unless said Berliner should show good and sufficient cause why said judgment should not be entered against him. On the 5th day of October, 1901, an order was made and the parties were notified that a judgment of priority of invention of the matter in issue would be rendered against the said Berliner on the 15th day of October, 1901, for the reason that he is the junior party and has taken no testimony in the case, unless he should on or before that day show good



1061

and sufficient cause why the same should not be done. Such time having expired and no sufficient cause having been shown, judgment of priority of invention is hereby rendered in favor of Joseph W. Jones, in accordance with said order and under the provisions of Rule 119. Limit of appeal from this decision will expire November 6, 1901.

WALTER JOHNSON  
Examiner of Interferences.

1062

Intf. No. 21,102 Paper No. 18

[ENDORSED:] Intf. No. 21,102 Paper No. 18 Berliner v. Jones. Decision in favor of Jones. Oct. 17, 1901. Recorded Vol. 67, Page 454.

BERLINER

v.

JONES.

# 21,102

1063

1. Apr. 17, 1901, Declaration. Prel. hearing May 10—1901
2. May 6th, " Statement of Jones,
3. " " " Letter to "
4. " 10, " Statement of Berliner. 1064
5. " " " Letter to "
6. " 13, 1901, Letter to Berliner extending preliminary hearing to May 24—1901.
7. " " " Letter to Jones extending preliminary hearing to May 24—1901.
8. " 24, " Amended Statement of Berliner
9. " " " Letter to "
10. " 25, " Times set for taking testimony. Hearing Sept. 12—1901.



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11. June 20, 1901. Motion by Berliner for dissolution
12. " 27, " Motion to dissolve trans. to Pr. Ex. Taking of testmy suspended
13. July 31, " Brief for Jones in Opposition of Berliners motion
14. Aug. 13, " Decision of Primary Examiner on motion
15. " 16, 1901, Proceedings resumed. Times reset. Hearing Nov. 15, 1901.
16. Sept. 30, " Motion by Jones for judgment
17. Oct. 5, " Order to show cause Oct. 15, 1901.
18. " 17, " Decided in favor of Jones. L. A. Nov. 6, 1901.

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# INDEX.

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## INTERFERENCE.

No. 21,102

BERLINER

VS.

JONES

## SUBJECT-MATTER:

1068

Gramophone Sound Records &  
Method of Making Same.



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Vol. 22.	Vol. 36
	p. 104

1901

## INTERFERENCE.

Case

No. 21,102

10

EMILE BERLINER  
Sr. No. 8537

1070

VS

JOSEPH W. JONES  
Sr. No. 659,170

Gramophone Sound-Records and Method of Making  
Same.

Division 23.

1071

1901

Apr. 17/1901.

## ATTORNEYS.

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1072

Asso.

PHILIP MAURO,  
Washington,  
D. C.

[ENDORSED:]

50157/05

U. S. Patent Office,  
Copy made Mar 18 1905.